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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,404	10/08/2003	Yoshinori Kawamura	Q77907	4340

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SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

EVANISKO, LESLIE J

ART UNIT PAPER NUMBER

2854

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/680,404

Applicant(s)

KAWAMURA ET AL.

Examiner

Leslie J. Evanisko

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-13 and 15 is/are rejected.
- 7) ☒ Claim(s) 8 and 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2004-03-05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the embodiment in which the image recording surfaces of the image recording materials face upward and the take-out mechanism transfers the pair of interleaf sheet and recording material to the conveying mechanism with the interleaf sheet positioned as is (as recited in claims 7 and 13) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be

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renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: reference numerals **15A** and **15B** in Figure 1 and reference numeral **12A** in Figure 2 have not been described in the specification.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct

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any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

4. Claim 1-9 are objected to because of the following informalities:

With respect to claim 1, it is suggested that the term "a cassette" in line 2 be deleted and replaced with --at least one cassette-- since claim 2 recites a plurality of cassettes. This change would insure it is clear that claim 2 is further limiting claim 1, rather than modifying the scope of claim 1. Appropriate correction and/or clarification is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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6. Claims 1-7, 9-13, and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Kawamura et al. (US 6,729,237 B2).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Kawamura et al. teach an image recording material sheet conveying device comprising a cassette accommodating section having a cassette **38** with recording materials **12** and interleaf sheets **50** accommodated therein, a take-out mechanism **15** for taking out a pair of an image recording material and interleaf sheet, a conveying mechanism **108** conveying the pair along a predetermined path, a peeling mechanism **62, 90, 92** for peeling the interleaf sheet **50** off the image recording material **12**, and an interleaf sheet conveying mechanism **56**,

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66 for conveying the interleaf sheet along a different path than the conveying path.

With respect to claim 2, note column 6, lines 64-67.

With respect to claims 3 and 5, note column 7, lines 26-29.

With respect to claim 4, note the suction mechanism 52 shown in Figures 1, 4, and 5 in particular.

With respect to claims 6 and 12, note the embodiment shown in Figure 5 and described in columns 9-10.

With respect to claims 7 and 13, note the embodiment shown in Figures 1 and 4 and described in columns 7-8.

With respect to claim 9, note Kawamura et al. teach an interleaf stacking section (i.e., discard box) in column 8, lines 1-3.

With respect to claims 10 and 15, note the above comments with respect to claim 1 and further note that Kawamura et al. includes an exposure station including a drum **16** and recording head **37** (see column 6, lines 34-43) as recited.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214

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USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-7, 9-13, and 15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,729,237 in view of Otsuji (US 6,341,932 B1). Claims 1-15 of US '237 teach a conveying device including a take-out mechanism, conveying mechanism, peeling mechanism, and interleaf sheet conveying mechanism as recited. Although claims 1-15 of US '237 do not specifically positively recite a cassette accommodating section or cassette, the broad provision of a cassette accommodating section including a cassette holding alternately stacked recording materials and interleaf sheets in a image recording device is well known in the art, as exemplified by Otsuji in Figure 5. In view of this teaching, it would have been obvious to one of ordinary skill in the art to provide a cassette accommodating section housing a cassette as taught by Otsuji in the device of US '237 to provide a compact area for storing printing plates to be fed to the image recording device.

With respect to claim 2, again note Otsuji teach a cassette accommodating section including at least two cassettes disposed at different positions in the vertical direction.

With respect to claim 4, note claims 2 or 8 of US '237.

With respect to claims 6 and 12, note claims 3 and 6 of US '237.

With respect to claims 7 and 13, note claims 4 of US '237.

With respect to claim 10 and 15, note claim 15 of US '237.

Allowable Subject Matter

9. Claims 8 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fails to teach or fairly suggest a sheet conveying device having all of the structure as recited, in combination with and particularly including, a retarding roller, leading end detecting sensor, and moving mechanism as recited. Note that Kawamura et al. do teach a similar peeling mechanism in Figures 7A and 7B. However, the peeling mechanism shown in Figures 7A and 7B does not include the specific detailed structure as recited, such as a retarding roller movable towards and away from the conveying path, a leading end detecting sensor detecting the leading end of the interleaf sheet and

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recording material, and a moving mechanism for moving the retarding roller based upon results of the detection of the sensor.

Conclusion


11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Schön et al. (US 4,402,592), McIlwraith (US 6,550,388), Koizumi et al. (US 2004/0112534 A1), and Shibabuki et al. (US 2004/0112233 A1) each teach a plate conveying apparatus having obvious similarities to the claimed subject matter.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Leslie J. Evanisko** whose telephone number is **(571) 272-2161**. The examiner can normally be reached on M-Th 7:30 am-6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H. Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Leslie J. Evanisko
Primary Examiner
Art Unit 2854

lje
August 5, 2004